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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/770,569	01/26/2001	Cynthia M. Merkin	16356.572 (DC-02618)	7616
27683	7590	03/11/2005	EXAMINER	
HAYNES AND BOONE, LLP 901 MAIN STREET, SUITE 3100 DALLAS, TX 75202			CAO, CHUN	
			ART UNIT	PAPER NUMBER
			2115	

DATE MAILED: 03/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/770,569

Applicant(s)

MERKIN ET AL.

Examiner

Chun Cao

Art Unit

2115

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 1/11/05 and RCE filed on 2/1/05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-30 are presented for examination.
2. The text of those applicable section of Title 35, U.S. Code not included in this action can be found in the prior Office Action.

Continued Examination Under 37 CFR 1.114

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/1/05 has been entered.
4. Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bell et al. (Bell), US patent no. 5,875,293 in view of Schaefer (Schaefer), U.S. Patent No. 6,487,610.

Bell and Schaefer are the references cited in prior office action.

As per claim 1, Bell discloses a system [fig. 1] comprising:

a computer system [100, fig. 2A] under test [fig. 1; col. 2, lines 22-25, 59-67; col. 5, lines 9-22] including a processor and a memory [col. 5, lines 45-64] and configured to boot using a system firmware [col. 5, lines 32-35], the system firmware including instructions for causing the computer system to:

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a test apparatus coupled to the computer system [col. 2, lines 28-32, 59-67; col. 5, lines 32-39]; and

initiate a manufacture mode of the system firmware [col. 5, lines 32-35]; and
in response to the manufacturing mode being initiated, instructions in the computer system transfer a control code between the computer system and the test apparatus [col. 10, lines 32-51].

Bell fails to detect a test apparatus coupled to the computer system, and initiate a manufacturing mode of the system firmware in response to detecting the test apparatus coupled to the computer system.

Schaefer teaches that a system firmware including instructions for causing the computer system to detect a test apparatus coupled to the computer system [col. 4, lines 4-11; col. 6, lines 49-61; col. 7, lines 39-41, 48-50], and initiating a manufacturing mode of the system firmware in response to detecting the test apparatus coupled to the computer system [col. 1, lines 62-63; col. 3, lines 45-66; col. 4, line 62-col. 5, line 6; col. 8, lines 1-6, 21-30].

It would have been obvious to one of ordinary skill in the art at time the invention to combine the teachings of Bell and Schaefer because they both teach a computer system for manufacturing testing, and the specific teaching of Schaefer states above would improve the efficiency of Bell's system by automatically initiating a manufacturing mode under test a computer system if a test apparatus is detected.

As per claim 2, Schaefer discloses that the system firmware includes instructions for causing the computer system to:

provide a first value to the test apparatus [col. 6, lines 49-51; col. 7, lines 39-41, 48-50]; receive a second value from the test apparatus in response to providing the first value to the test apparatus [col. 7, lines 61-64]; and initiate the manufacturing mode in response to receiving the second value from the test apparatus [col. 8, lines 1-30].

As to claims 3-6, Bell discloses the invention as claimed including perform an input/output operation to cause the test apparatus to access the control code, perform a memory operation to cause the test apparatus store the information provided onto the computer system [figs. 5, 6; col. 10, line 57-col. 11, line 7; col. 17, lines 42-49].

As per claim 7, Schaefer discloses that the system firmware includes instructions for causing the computer system to:

not initiate the manufacturing mode in response to not receiving the second value from the test apparatus [col. 7, lines 55-61].

As per claim 8, Bell discloses that the manufacturing mode of the system firmware includes instructions for causing the computer system to: receive information from the test apparatus; and store the information on a device in the computer system [col. 5, lines 27-29].

As per claim 9, Bell discloses that the manufacturing mode of the system firmware includes instructions for causing the computer system to: store the system firmware on a device in the computer system [col. 5, lines 27-29].

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5. As to claims 10-18, Bell and Schaefer together teach the claimed system.

Therefore, Bell and Schaefer together teach the claimed computer program product for carrying out the system.

6. As to claims 19-27, Bell and Schaefer together teach the claimed system.

Therefore, Bell and Schaefer together teach the claimed method of steps for carrying out the system.

7. As to claims 28-30 are written in means plus function format and contained same limitations as claims 1-3, therefore same rejection is applied.

8. Applicant's arguments filed on 1/11/2005 have been fully considered but are not persuasive.

9. In the remarks, applicant argued in substance that the cited references do not teach or suggest 1) in response to the manufacturing mode being initiated, instructions in the computer system transfer a control code between the computer system and the test apparatus. 2) There is simply no basis in the art for combining the references to support a 35 U.S.C. 103 rejection because neither Bell et al. patent nor the Schaefer patent teaches or even suggests the desirability of the combination. Moreover, neither patent provides any incentive or motivation supporting the desirability of the combination.

The examiner respectfully submits that applicant's position is not persuasive. As to 1) Bell discloses in response to the manufacturing mode being initiated, instructions

in the computer system transfer a control code between the computer system and the test apparatus [col. 10, lines 32-51]. Also see detail rejection of claim 1 above.

In response to applicant's argument that 2) there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Bell fails to detect a test apparatus coupled to the computer system, and initiate a manufacturing mode of the system firmware in response to detecting the test apparatus coupled to the computer system. However, Schaefer teaches that a system firmware including instructions for causing the computer system to detect a test apparatus coupled to the computer system [col. 4, lines 4-11; col. 6, lines 49-61; col. 7, lines 39-41, 48-50], and initiating a manufacturing mode of the system firmware in response to detecting the test apparatus coupled to the computer system [col. 1, lines 62-63; col. 3, lines 45-66; col. 4, line 62-col. 5, line 6; col. 8, lines 1-6, 21-30]. It would have been obvious to one of ordinary skill in the art at time the invention to combine the teachings of Bell and Schaefer because they both teach a computer system for manufacturing testing, and the specific teaching of Schaefer states above would improve the efficiency of Bell's system by automatically initiating a manufacturing mode under test a computer system if a test apparatus is detected.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chun Cao whose telephone number is 571-272-3664. The examiner can normally be reached on Monday-Friday from 7:30 am-4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas C. Lee can be reached on 571-272-3667. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is 571-272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Chun Cao

Mar. 7, 2005